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09/826,741	04/05/2001	Hanh Kim Le	AUS920010059US1	6063

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EXAMINER

HUTTON JR, WILLIAM D

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/826,741

Applicant(s)

LE ET AL.

Examiner

Doug Hutton

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07162001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

***Claim 8:***

The claim recites a "computer program product" comprising "instruction means." As currently specified, the invention is functional descriptive material because it comprises merely a data structure.

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760. Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention that permit the data structure's functionality to be realized.

In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

These rejections may be obviated by amending the preamble of Claim 8 to read:

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"A computer-readable media in a client computer system coupled to a server computer system for efficiently retrieving information, said server computer system including a database storing a plurality of data items and unique information associated with each one of said plurality of data items, said computer-readable media comprising:"

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

*Claims 1, 8 and 15:*

These claims recite that the invention comprises "retrieving information related to said one of said plurality of data items from said data entry form ***without accessing said database***" (emphasis added). However, both the "data items" and the "related information" for each data item are initially retrieved from the database when the user requests the data entry form. Thus, the "related information" is not retrieved "without

accessing the database.” Rather, the database is initially accessed to retrieve the data entry form, the data items and the related information.

Applicant’s claims are too broadly worded and recite subject matter that is not enabled in the disclosure.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 6-9, 13-16, 20 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by [http://web.archive.org/web/20001109084100/http://shopping.hp.com/cgi-bin/hpdirect/shopping/scripts/home/start\\_home.jsp](http://web.archive.org/web/20001109084100/http://shopping.hp.com/cgi-bin/hpdirect/shopping/scripts/home/start_home.jsp) from the Internet Archive Wayback Machine (hereinafter, “Webpage”).

#### ***Claim 1:***

Webpage discloses a method in a client computer system coupled to a server computer system for efficiently retrieving information, said server computer system including a database storing a plurality of data items and unique information associated with each one of said plurality of data items (see Pages 1-4; see the source code for

Page 1 (hereinafter, "Source Code" – the webpage is stored on a database and includes "data items" and "unique information" corresponding to each said data item), said method comprising the steps of:

- displaying, on said client computer system, a data entry form which includes a plurality of fields (see Page 2);
- receiving input data for one of said plurality of fields, said input data being one of said plurality of data items (see Page 2 – Field 1 receives input from user; the input is one of the data items);
- retrieving information related to said one of said plurality of data items from said data entry form without accessing said database (see Pages 2-4; see Source Code – upon entry of input into Field 1, the webpage retrieves information related to the input without accessing the database in that the related information is part of the webpage that is sent to the client computer when the data entry form is requested by the user, as indicated in Source Code); and
- displaying said information utilizing said data entry form (see Pages 3-4).

*Claim 2:*

Webpage discloses the method according to Claim 1, further comprising the steps of:

- storing, utilizing said server computer system, plurality of data items in a first field which is hidden in said data entry form, said first field being invisible to users

(see Source Code; see Page 1 – the data items are stored in a “first field” that is hidden in said data entry form and invisible to users); and

- storing, utilizing said server computer system, unique information associated with said plurality of data items in a second field which is hidden in said data entry form, said second field being invisible to users (see Source Code; see Page 1 – the information is stored in a “second field” that is hidden in said data entry form and invisible to users).

*Claim 6:*

Webpage discloses the method according to Claim 1, further comprising the steps of:

- requesting, utilizing said client computer system, said data entry form from said server computer system (the user requests the data entry form from the server either by navigating the hpshopping.com webpage or typing in the URL); and
- downloading said data entry form from said server computer system to said client computer system (the client computer downloads the webpage from the server).

*Claim 7:*

Webpage discloses the method according to Claim 1, further comprising the steps of:

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- displaying said data entry form utilizing a web browser executing on said client computer system (the data entry form is displayed in a browser on the client computer); and
- retrieving information related to said one of said plurality of data items from said data entry form utilizing a Java script executing on said client computer system (the related information is retrieved using a Java script).

*Claims 8, 9, 13 and 14:*

These claims are merely for computer software that performs the method of Claims 1, 2, 6 and 7, respectively. Thus, these claims are rejected using the same rationale in the above rejections for Claims 1, 2, 6 and 7.

*Claims 15, 16, 20 and 21:*

These claims are merely for a computer system that performs the method of Claims 1, 2, 6 and 7, respectively. Thus, these claims are rejected using the same rationale in the above rejections for Claims 1, 2, 6 and 7.

***Allowable Subject Matter***

Claims 3-5, 10-12 and 17-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the

limitations of the base claim and any intervening claims. Additionally, these claims must be amended to overcome the rejections under 35 U.S.C. 101 and 112, first paragraph.

The following is a statement of reasons for the indication of allowable subject matter:

*Claims 3, 10 and 17:*

The prior art fails to disclose or suggest a method in a client computer system coupled to a server computer system for efficiently retrieving information that includes every step of Claims 1-3, 8-10 and 15-17.

*Claims 4, 5, 11, 12, 18 and 19:*

These claims are dependent upon Claims 3, 8 and 17, respectively, and thus include allowable subject matter.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Markus et al., U.S. Patent No. 6,490,601; Rawat, U.S. Patent No. 6,662,340; Gupta et al., U.S. Patent No. 6,199,079; Light et al., U.S. Patent No. 6,192,380; Larsen et al., U.S. Patent No. 6,088,700; and Kikinis, U.S. Patent No. 5,794,259.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (703) 305-1701. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

WDH  
June 8, 2004

  
**HEATHER HERNDON**  
**SUPERVISORY PATENT EXAMINER**  
**TECH CENTER 2100**